

Confirmation No. 9960

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	MUTH	Examiner:	Zaman, F.
Serial No.:	10/534,164	Group Art Unit:	2111
Filed:	May 5, 2005	Docket No.:	DE020252US (NXPS.206PA)
Title:	INTEGRATED CIRCUIT WITH LIN-PROTOCOL TRANSMISSION		

REQUEST FOR RECONSIDERATION OF APPEAL DECISION

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Customer No.

65913

Dear Sir:

This Request for Reconsideration is submitted pursuant to 37 CFR § 41.52 and in response to the Appeal Decision dated January 12, 2010. Please reconsider the Appeal Decision in view of the following arguments and remarks.

Authorization is provided to charge **Deposit Account No. 50-4019 (DE020252US)** any fees related to this filing.

Arguments

The Board Of Patent Appeals And Interferences (“Board”) Should Expressly Recognize That, For Claims 1-6, The Appeal Decision Reversed The Examiner And Introduced New Grounds Of Rejection.

Appellant requests that the Board reconsider the affirmation of the Examiner's rejection and clarify that 1) the Examiner was reversed and 2) that new grounds of rejection have been introduced in the Instant Appeal Decision. As explained herein the Board improperly indicated that the Examiner was affirmed and further failed to properly indicate that new grounds for rejection were presented. Appellant submits that the issues raised herein are a direct consequence of the Board's decision and presentation of new grounds of rejection. Thus, Appellant could not have raised these issues earlier. Had the Board correctly identified the new grounds of rejection, after having reversed the Examiner's arguments at nearly every turn, Appellant would have been afforded the opportunities provided under the relevant legal standards and rules.

The overarching issue in the instant Appeal was whether Appellant showed reversible error in the Examiner's findings regarding the alleged teachings of the references and the articulated reasoning for the legal conclusion of obviousness. The Board's point-by-point analysis of the Examiner's findings unequivocally answers this question in the affirmative. The record shows that Appellant contested numerous conclusions and factual findings made by the Examiner, any one of which were fatal to each of the Examiner's rejections of claims 1-6 under 35 U.S.C. § 103(a) (the “Examiner's rejection”). The Board confirmed that Appellant's points of contention were proper and that the Examiner's rejection was improper. Thus, Appellant successfully overcame all rejections presented by the Examiner.

The Board effectively overturned the Examiner's rejection by affirming several flaws that were each individually sufficient to render the rejection improper. The Board then introduced new theories, legal conclusions and findings of fact. In particular, the Board presented: 1) a new theory on the content of AAPA; 2) a material change to the Examiner's

alleged combination; and 3) a new articulated reasoning for the new combination. Despite these modifications, the Board’s decision has denied Appellant the opportunity to produce evidence and argument, which might rebut the Board’s materially-different grounds of rejection.

The affirmation of an Examiner upon a previously “nonexistent rejection violates the statutory mandate that the Board review ‘adverse decisions of examiners upon applications for patents,’ 35 U.S.C. § 6(b) (2000) (emphasis added), as well as the strictures of 37 C.F.R. § 1.196(a), which specifies that with respect to the grounds of rejection before it, the Board, in deciding the appeal, must either ‘affirm or reverse the decision of the examiner . . . on the grounds and on the claims specified by the examiner, or remand the application to the examiner for further consideration’ (emphasis added).” *In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002).

New grounds of rejection should be acknowledged when changes are made to the *precise reason* for the rejection and not upon the statutory basis alone. *See, e.g., Hyatt v. Dudas*, 551 F.3d 1307, 1312 (Fed. Cir. 2008) (“a ‘ground of rejection’ for purposes of Rule 1.192(c)(7) is not merely the statutory requirement for patentability that a claim fails to meet but also the precise reason why the claim fails that requirement.”) Accordingly, it is not proper to materially-change the precise reason for the rejection without acknowledging that such a change represents a new ground of rejection.

Moreover, the PTO places prohibitions on the entrance of new evidence by a patent applicant at this late stage of prosecution¹. These prohibitions encourage an Applicant to present evidence at an early stage of prosecution and thereby help ensure that the issues are clearly laid out before an Appeal to the Board is made. As a *quid pro quo*, the PTO rules

¹ *See, e.g., M.P.E.P. § 1206* (“An amendment, affidavit or other evidence received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded or returned by the Board for such purpose”)

state new grounds for rejection should be identified as such². The identification of such new grounds is of vital import as new grounds are not considered final for judicial review and also affords a patent applicant with several procedural options for addressing the new grounds³.

The logic behind such requirements should be clear. For instance, had the Examiner correctly recognized the errors in the Examiner's rejection, as acknowledged by the Board, the Examiner would have been required to withdraw the rejections and either allow the case or present a new basis for rejecting the claims. Appellant would have then had ample opportunity to respond with argument and evidence or, if necessary, to make amendments to the claims. Appellant should not be denied this opportunity simply because the Examiner failed to recognize these deficiencies, thereby forcing the Board to temporarily take the place of the Examiner. Here, the Board has confirmed the Examiner's failure to recognize the deficiencies in the rejection, yet the Board has improperly affirmed the Examiner. Regardless of the validity of any newly-crafted grounds for rejection, the record clearly indicates that Appellant successfully overcame all issues presented in the Appeal and that the Examiner's rejections should have been reversed.

Appellant recognizes that the PTO rules grant the Board the power to put forth new grounds for rejection. In doing so, the Board effectively takes the place of the Examiner by presenting new arguments, evidence and/or findings of fact; however, the PTO rules also provide several avenues of recourse for an Appellant should the Board choose to exercise this power. If patent applicants were to be denied such avenues of recourse, the ramifications would be severe. For instance, any error in the Board's newly presented argument could not be rebutted by argument or evidence⁴. Since it would be unreasonable to expect an Applicant

² See, e.g., 37 C.F.R. § 41.50 ("Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim.")

³ See, e.g., 37 C.F.R. § 41.50 ("A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.")

⁴ See, e.g., 37 C.F.R. § 41.52(a)(1) "Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section."

to predict any and all conceivable positions that the PTO might take with regards to a particular set of facts, irrespective of their validity, any denial of such recourse is not merely a harmless error.

In this instance, the Board presented new factual conclusions, new assertions of correspondence and at least one new reasoning for the legal conclusion of obviousness. In particular, the Board reached several new conclusions of fact regarding various teachings of the prior art as well as presenting new articulated reasoning for the legal conclusion of obviousness⁵. The Board found these new conclusions necessary, in part, because the Examiner's basis for rejecting the claims was found lacking and also because many of the Examiner's findings and arguments were contrary to the Board's findings. For example and although incorrect, the Examiner's rejection of claims 1-6 required that these elements be found in the Ishikuri and Feuerstraeter references. The Examiner also expressly stated that a system-based chip having such aspects was not taught by AAPA. The Board, however, disagreed with the Examiner on both accounts.

Throughout prosecution Appellant has addressed the particular failings of the Examiner's grounds for rejection. In nearly every instance, the Board agreed with Appellant and thereby effectively reversed the Examiner on substantially all issues of the Appeal including the validity of the Examiner's grounds of rejection. After reaching these conclusions, the Board presented a set of new findings of fact, arguments and legal conclusions. Thus, even though the Board rejected the claims using the same statutory basis, the Board clearly changed the *precise reason* for why the claims were asserted as failing a statutory requirement. The PTO rules, as interpreted by the Federal Circuit, require that such changes be considered new grounds. *Hyatt v. Dudas*, at 1312 (Fed. Cir. 2008). In view of this material change in the precise reason for rejecting the claims, the Board should not have affirmed the Examiner and should have recognized that new grounds for the rejection were presented.

⁵ See, e.g., *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (U.S. 2007) (A clearly articulated reasoning is an important element for ascertaining the validity of a legal conclusion of obviousness.)

The Board indicated that the Examiner's error was harmless; however, the Board's improper affirmation has the effect of precluding Appellant from presenting new arguments and evidence that would rebut the new findings, arguments and legal conclusions. Without having been afforded the required avenues of recourse, such as those provided by 37 C.F.R. § 41.50(b), Appellant has been improperly denied the opportunities required by an Administrative Procedure Act⁶. As examples of possible harm, Appellant submits the very real possibility that the Board may have overlooked a material aspect of the record, failed to consider one or more factors relevant to patentability or simply was unaware of additional evidence that has not been submitted, such evidence might shed additional light on the Board's new findings.

For at least these reasons, the Board should acknowledge the new grounds for rejection and afford Appellant the avenues of recourse required by the PTO rules. The following discussion details a number of changes made to the precise reasons for the rejection relative to the Examiner's grounds of rejection.

The Board alleged that AAPA discloses a system base chip that has a system voltage supply, a system reset and a monitoring function, whereas this precise reasoning had never been alleged by the Examiner. The Board further introduced new grounds of rejection by presenting a different combination of references relative to the combination relied on by the Examiner and upon which the evidence and arguments of record addressed. The Examiner's rejections of claims 1-6 each rely upon the Ishikuri reference. Specifically, the Examiner alleged that the Ishikuri reference teaches a system voltage supply and a system reset and that the skilled artisan would combine such aspects with the device of AAPA (Appellant's admitted prior art). The Board concluded that the Examiner "errs in finding that Ishikuri teaches a system voltage supply for the reasons stated by Appellant at Br, 7-8." *See Page*

⁶ See, e.g., *In re Kumar*, 418 F.3d 1361, 1367 (Fed. Cir. 2005) ("In accordance with the Administrative Procedure Act, the agency must assure that an applicant's petition is fully and fairly treated at the administrative level, without interim need for judicial intervention. See *Dickinson v. Zurko*, 527 U.S. 150, 154, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (the PTO is an agency subject to the Administrative Procedure Act). The Board's rules are in accord. See 37 C.F.R. § 1.196(b) (when the Board relies on a new ground of rejection, it is appropriate to provide the applicant with an opportunity to respond to that ground).")

10:4-7 of the Appeal Decision. The Board then concluded that the Ishikuri reference is not needed for these limitations. However, the Examiner expressly relied upon the Ishikuri reference for the rejections of claims 1-6. This new assertion by the Board represents more than a harmless oversight on the part of the Examiner as it requires a material change to the precise reasons for the rejection. As such, the Board's removal of the Ishikuri reference as a basis for the rejections of claims 1-6 constitutes new grounds of rejection.

Moreover, the Board acknowledged that the Examiner's reasoning for why the skilled artisan would combine the cited teachings of the Feuerstraeter reference with AAPA were based on an impermissible use of Appellant's specification. Specifically, the Examiner asserted that the skilled artisan would combine these references to "eliminate the need for a dedicated external microcomputer" resulting "in less cost to implement the system." The Board concluded that "this reasoning sounds like an impermissible use of Appellant's specification." *See* page 13:21 to page 14:1 of the Appeal Decision. The Board then provided its own reasoning regarding why the skilled artisan would combine the Feuerstraeter reference with AAPA. *See, e.g.*, page 14:1-3 of the Appeal Decision. Explicit and clearly articulated reasoning is an important element for the legal conclusion of obviousness. Thus, the Board's replacement of the Examiner's reasoning for the proposed combination with its own reasoning constitutes a material change in the precise reasons for the rejection. Thus, the Board has presented new grounds of rejection for claims 1-6.

In addition, the Board concluded that the Examiner erred in finding that the transceiver of the Feuerstraeter reference performs a monitoring function. Specifically, the Board found that the Examiner's assertion that Feuerstraeter's base chip has a transmitting and/or receiving system that performs a monitoring function was erroneous. *See, e.g.*, page 10:13-25 of the Appeal Decision ("The Examiner errs in finding that the transceiver performs a monitoring function."). The Board then changed the reasons for the rejection by concluding that such aspects were taught by AAPA. This also represents a material change to the precise reasons for the rejection. As such, the Board's conclusion that such aspects are

not taught by Feuerstraeter, but are instead taught by another reference, constitutes new grounds of rejection for claims 1-6.

In view of the above, Appellant respectfully requests that the Board acknowledge that the Examiner's rejections of claims 1-6 were reversed and that the rejections presented by the Board in the Appeal Decision are new grounds of rejection.

There Is Not A *Prima Facie* Case For Rejection Of Each Of Claims 2-6 Because The Board Did Not Address Limitations Of These Claims In With Regards To The New Grounds Of Rejection.

The record does not contain a *prima facie* case for the rejection of claims 2-6. The Board introduced material changes relative the factual findings of the Examiner, the alleged combination of references and the reason for the legal conclusion of obviousness. In doing so, the Board introduced a new basis for the rejection of claim 1; however, the Board failed to address the limitations of any of the remaining claims in view of the newly-presented grounds of rejection. Thus, there is not a *prima facie* case for the rejections.

To the extent that Appellant grouped claims for the instant Appeal, the grouping of claims was made with respect to the issues upon which the Appeal was originally based. Once the Board agreed that the Examiner's rejection was inadequate, the grouping of claims made by Appellant ceased to be applicable. To hold otherwise would deprive Appellant of being first apprised of the basis for the rejection and then being afforded an opportunity to respond thereto⁷.

Accordingly, the rejection of claims 2-6 should be reversed.

⁷ See, e.g., *In re Kumar*, 418 F.3d 1361, 1367 (Fed. Cir. 2005) ("these values produced and relied on by the Board had not previously been identified by the examiner or the Board. Kumar was entitled to respond to these calculations, and the Board committed procedural error in refusing to consider the evidence proffered in response.")

Serial No. 10/534,164
Docket No.: DE020252US
Request for Reconsideration of Appeal Decision

In view of the above, Appellant submits that the Board's decision reverses the Examiner's rejections of claims 1-6 and constitutes new grounds of rejection. Appellant therefore requests that these rejections be identified as new grounds of rejection by the Board so that Appellant is afforded a fair opportunity to respond thereto (*e.g.*, as provided under 37 C.F.R. § 41.50(b)).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

Respectfully Submitted,

By: 
Name: Robert J. Crawford
Reg. No.: 32,122
Shane Sondreal, Reg. No. 60,145
Tel: 651 686-6633 Ext. 2300
(NXPS.206PA)